

Remarks

Claims 11 –23 stand rejected under 35 USC 251 as being an improper attempt to recapture subject matter cancelled in the original patent upon which the present re-issue application is based. The examiner suggests by this rejection that the “through error” requirement of 35 USC 251 is not met in the present re-issue application with respect to claims 11 –23. It is respectfully submitted that this is not the case.

In the parent case, claims 1, 3 and 8 as originally presented were rejected over art and under 35 USC 112. In the 35 USC 112 rejection the examiner questioned whether the disk is magneto-optical disk and the meaning of the phrase “reproducible by a super resolution reproduction”. To overcome the rejection under 35 USC 112 on December 21, 1994 these claims were amended to insert limitations that the disk be a “magneto optical disk”, “to be reproduced by forming a light spot with a predetermined diameter thereon” and “recorded on said plurality of recording tracks as magnetization directions at said recording surface in a magneto-optical recording operation”. These limitations were not inserted to overcome prior art but to correct the 35 USC 112 informalities raised by the examiner. Indeed, address pit information and an information pit formed on a land sectioned by a groove is the acknowledged prior art of Fig. 1 and a “super resolution optical disk” is disclosed in the Japanese Applied Magnetic Academy’s paper mentioned in the first column of the original patent.

The art cited against the original claims was distinguished by (1) the information pits are arranged with a high pit density; and (2) address pit having “convex or concave shape on the recording surface [is] arranged with a low pit density”.

In the present re-issue application, the limitations that were directed to overcoming the

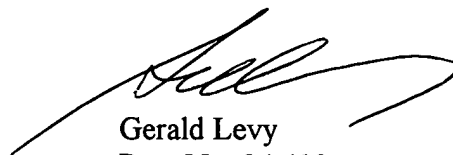
prior art is maintained in the new claims (see claim 11, lines 10 and 11; claim 14, lines 11 and 12; and claim 20, lines 9 and 10). Only limitations which were erroneously added to correct the 35 USC 112 rejection are deleted from claims 11, 14 and 20.

The leading case in this area appears to be *In re Clement* 45 USPQ2d 1161 (Fed. Cir. 1197) cited by the examiner. As that case notes, the recapture rule, is applicable to prevent an applicant from re-prosecuting (in a re-issue application) claims amended to overcome a prior art rejection. Where a claim is amended to overcome a reference there is an implicit admission that the claim before amendment is not patentable over the reference. The recapture rule “does not apply in the absence of evidence that the applicant’s amendment was “an admission that the scope of the claim was not in fact patentable”. See the “Discussion” beginning on page 1163.

As noted above, new claims 11, 14 and 20 do not seek to recapture subject matter that was given up during the prosecution of the parent case to overcome prior art. The limitations to overcome the prior art re-appear in each of the new claims. What the new claims seek to do is to correct the error that was made by not fully appreciating the scope of the invention with regard to the amendments, that were made to the original claims to overcome the 35 USC 112 rejections. It is respectfully submitted that with regard to such amendments the recapture rule is inapplicable.

In view of the above, it is respectfully submitted that claims 11 –23 are not an improper recapture attempt but rather properly seek to correct applicant’s claiming less than he was entitled to claim. Accordingly, it is respectfully submitted that these claims should be allowed.

Respectfully submitted,



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